

### **REMARKS**

Claims 1-33, all the claims pending in the application, stand rejected on prior art grounds. Claim 24 stands objected to upon informalities. Claims 1, 11, 12, 22-24, and 33 are amended herein. Applicants respectfully traverse these objections/rejections based on the following discussion.

#### **I. The Objections to the Claims**

Claim 24 is objected to as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicants herein amend claim 24 to remove the language that is duplicative of the language provided in claim 23. In view of the foregoing, the Examiner is respectfully requested to reconsider and withdraw the objection.

#### **II. The Prior Art Rejections**

Claims 1-33 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Smyth et al. (U.S. Patent No. 7,028,261) hereinafter referred to as "Smyth", in view of Huang et al. (U.S. Publication No. 2002/0133569), hereinafter referred to as "Huang", in further view of O'Brien et al (U.S. Patent No. 6,055,569), hereinafter referred to as "O'Brien". Applicants respectfully traverse these rejections based on the following discussion.

Smyth teaches an internet website which presents a hierarchical menu structure to users includes a personalization engine to automatically modify the menu structure for each user at least according to that user's previous browsing history at the site. In one embodiment the engine provides, as menu options for a selected menu page of the hierarchical menu, a plurality of the most probable links which the user may wish to reach from the selected menu page. In

another embodiment there are provided, as additional menu options for a particular menu page, a plurality of links which are similar, as determined by meeting a predetermined similarity metric, to menu options present on the particular menu page other than through meeting the similarity metric.

Huang teaches a computer-implemented method and system for processing transactions between a client device and a web page. The system includes an adapter for receiving and interpreting a request from the client device, wherein the adapter is configured to interface with the client device. A generator retrieves a web page specified by the request. A transcoder receives the retrieved web page and applies a transcoding rule to extract data from the web page. The transcoding rule used is one of a set of predefined rules relating to the web page. The transcoder also transforms the data into a standardized form so that the adapter can then modifying the standardized data into a compatible form for display by the client device. Therefore, web based transactions can be performed by a variety of client devices, including portable, wireless and voice-based devices.

O'Brien teaches a smart browser working in conjunction with a HTTP server that selectively downloads WWW pages into the browser's memory cache. The determination of which pages to download is a function of a probability weight assigned to each link on a Web page. By evaluating that weight to a predetermined browser criteria, only those pages most probably to be downloaded are stored in the browser's memory cache. The download is done in the background while the browser user is viewing the current Web page on the monitor. This greatly enhances the speed with which the viewer can "cruise" the Web while at the same time conserving system resources by not requiring the system to download all the possible links.

However, the claimed invention, as provided in amended independent claims 1, 11, 12,

22, 23, and 33 contain features, which are patentably distinguishable from the prior art references of record. Specifically, claims 1 and 23 recite, in part, "...identifying, in response to said request, components of said application that may be requested by said user in the future, wherein the identifying process comprises associating a penalty with an incorrect prediction of said components of said application that may be requested by said user in the future and biases a probability of selection of successive components more towards recently occurring historical patterns than older historical patterns...." Similarly, claim 12 recites, in part, "...a processing unit coupled to said at least one communications interface and said memory unit, said processing unit programmed to: receive a request for a component of said application from a device operated by a user of said application; identify, in response to said request, components of said application that may be requested by said user in the future; associate a penalty with an incorrect prediction of said components of said application that may be requested by said user in the future and biases a probability of selection of successive components more towards recently occurring historical patterns than older historical patterns...."

Additionally, claim 11 and 33 recite, in part, "...identifying, in response to said request, components reachable from said requested component, wherein the identifying process comprises graph analysis, statistical analysis, learning analysis, and response-time analysis, and wherein said learning analysis associates a penalty with an incorrect prediction of said components of said application that may be requested by said user in the future and biases a probability of selection of successive components more towards recently occurring historical patterns than older historical patterns...." Likewise, claim 22 recites, in part, "...a processing unit coupled to said at least one communications interface and said memory unit, said processing unit programmed to: receive a request for a component of said application from a device;

identify, in response to said request, components reachable from said requested component, wherein the identifying comprises graph analysis, statistical analysis, learning analysis, and response-time analysis, and wherein said learning analysis associates a penalty with an incorrect prediction of said components of said application that may be requested by said user in the future and biases a probability of selection of successive components more towards recently occurring historical patterns than older historical patterns....”

These features are neither taught nor suggested in the prior art references of record. That is, there is no teaching in Smyth, Huang, or O’Brien, either individually or collectively, that a penalty is associated with an incorrect prediction of components that may be requested. In fact, Smyth and O’Brien merely strive to predict the user’s future requests, but are silent about what happens when an incorrect prediction occurs, let alone, that a penalty is assessed. Also, Huang is silent as to prediction of future components all together. Additionally, there is no teaching in Smyth, Huang, or O’Brien, either individually or collectively, that graph analysis, statistical analysis, learning analysis, and response-time analysis are used to identify components reachable from a requested component. Therefore, the prior art fails to teach or reasonably suggest at least one element of the Applicants’ claims, and accordingly, the Applicants’ claims are patentable over the combination of Smyth, Huang, and O’Brien.

Additionally, the Office Action has failed to indicate a proper motivation for combining Smyth, Huang, and O’Brien in the piecemeal approach taken in the Office Action. Insofar as references may be combined to teach a particular invention, and the proposed combination of Smyth, Huang and O’Brien, case law establishes that, before any prior-art references may be validly combined for use in a prior-art 35 U.S.C. § 103(a) rejection, the individual references themselves or corresponding prior art must suggest that they be combined. However, there is

nothing in each of the references that suggests such a motivation to combine as suggested in the Office Action. In fact, had such a motivation been anticipated in any of the prior art references, then surely some discussion regarding alternative embodiments or manners of combination would have been suggested or at least inferred in any of the prior art references. In fact, no suggestion for combination is provided in any of the prior art references.

Page 3 of the Office Action attempts to provide such a motivation for combination by citing column 1, lines 49-51 of Smyth as providing the motivation for combination. However, the column 1, lines 49-54 of Smyth merely states, “[i]n short, ensuring that mobile users gain access to the right information at the right time, both quickly and easily, is key to the future success of the mobile/wireless information revolution, including the current generation of WAP-enabled services and the next generation of 3G information services.” There is nothing in the Applicants’ claims relating to mobile or wireless technologies. Next, page 4 of the Office Action attempts to further provide a motivation for combination by citing column 7, lines 52-53 of Smyth and column 1, lines 49-51 of Smyth as demonstrating a motivation to combine the teachings of Smyth with Huang and O’Brien. As indicated above, with respect to column 1, lines 49-51 of Smyth, since there is nothing in the Applicants’ claims relating to mobile or wireless technologies, then the quoted language in the Office Action could not be reasonably used by one of ordinary skill in the art in order to combine Smyth with Huang and O’Brien in an effort to teach the Applicants’ claimed invention. In other words, one of ordinary skill in the art would not find a combination of Smyth with Huang and O’Brien to be obvious and would have no motivation for combining the references together in the manner suggested in the Office Action in order to allow “mobile users [to] gain access to the right information at the right time, both quickly and easily.”

Additionally, claims 2, 13, and 24 do not merely recite using ‘time’ as one of the restraints, but rather, recite, in part, “...wherein in said response-time analysis a maximum number of components in the neighborhood of a current component that can be adapted within a desired response-time are adapted by: calculating the times required to adapt each respective component; given a maximum response time and starting from said current component, adding said times in a breadth first search order until a sum of the added times is less than said

maximum response time.” Accordingly, it is the entirety of the recited claimed language which must be provided in the prior art in order to properly reject the Applicants’ claims. In the present situation, the prior art does not teach the entirety of the Applicants’ claims, and as such the rejection is deficient.

Furthermore, pages 5 and 7-10 of the Office Action attempt to provide motivation for combination of Smyth with Huang and O’Brien for generally the same reasons as indicated above. However, one of ordinary skill in the art at the time of the Applicants’ invention would not likely combine references related to mobile or wireless technologies especially given the fact that the Applicants’ claims are not directed to these types of technologies. Accordingly, the reason given in the Office Action for the motivation to combine the references is moot and accordingly, the rejections are improper. Additionally, further evidence of the unobvious and unlikely combination of Smyth with Huang and O’Brien is established from the U.S. Patent & Trademark Office itself.

As evidence for the above, the Applicants note that even the USPTO has designated Smyth, Huang and O’Brien as non-analogous art. First, Smyth has been classified in U.S. classes 715/744; 715/745; 715/747; 715/765; and 715/763. Conversely, Huang has been classified in U.S. classes 709/219 and 705/37. Still conversely, O’Brien has been classified in U.S. classes 709/223; 709/203; and 709/224. Thus, there are no overlapping classes for Smyth, Huang and O’Brien. Therefore, if the USPTO with its vast repository of prior art references available for analysis has determined that Smyth, Huang and O’Brien are not classified in the same art field, and therefore unlikely to be combined with one another, then one of ordinary skill in the art would hardly be likely to combine Smyth with Huang and O’Brien in the manner suggested in the Office Action. In fact, such a combination would require extraordinary skill rather than mere ordinary skill; a standard inconsistent with 35 U.S.C. §103(a). Indeed, such a

combination is unobvious.

In In re Sernaker, 217 U.S.P.Q. 1, 6 (C.A.F.C. 1983), the court stated: “[P]rior art references in combination do not make an invention obvious unless something in the prior art references would suggest the advantage to be derived from combining their teachings.” Furthermore, the court in Uniroyal, Inc. v. Rudkin-Wiley Corp., 5 U.S.P.Q.2d 1434 (C.A.F.C. 1988), stated, “[w]here prior-art references require selective combination by the court to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself. . . . Something in the prior art must suggest the desirability and thus the obviousness of making the combination.” There is nothing in the prior art that refers to a suggestion or desirability of making the proposed combination. Accordingly, the rejection under 35 U.S.C. §103(a) is prima facie defective.

In the present application, the reason given to support the proposed combination is improper, and is not sufficient to selectively and gratuitously substitute parts of one reference for a part of another reference in order to try to meet, but failing nonetheless, the Applicants’ novel claimed invention. Moreover, there is nothing in the prior art references themselves, namely Smyth, Huang, and O’Brien, which suggests a motivation to combine elements from each reference in a manner consistent with the suggestion by the Office Action. Furthermore, the claimed invention meets the above-cited tests for obviousness by including embodiments such as “identifying, in response to said request, components of said application that may be requested by said user in the future, wherein the identifying process comprises associating a penalty with an incorrect prediction of said components of said application that may be requested by said user in the future and biases a probability of selection of successive components more towards recently occurring historical patterns than older historical patterns;” and “identifying, in response

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to said request, components reachable from said requested component, wherein the identifying process comprises graph analysis, statistical analysis, learning analysis, and response-time analysis, and wherein said learning analysis associates a penalty with an incorrect prediction of said components of said application that may be requested by said user in the future and biases a probability of selection of successive components more towards recently occurring historical patterns than older historical patterns." As such, all of the claims of this application are, therefore, clearly in condition for allowance, and it is respectfully requested that the Examiner pass these claims to allowance and issue.

As declared by the Federal Circuit:

In proceedings before the U.S. Patent and Trademark Office, the Examiner bears the burden of establishing a prima facie case of obviousness based upon the prior art. The Examiner can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. In re Fritch, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992) citing In re Fine, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988).

Here, the Examiner has not met the burden of establishing a prima facie case of obviousness. It is clear that, not only does Smyth fail to disclose all of the elements of the claims of the Applicants' claimed invention, but also, if combined with Huang and O'Brien, fails to disclose these elements as well. The unique elements of the claimed invention are clearly an advance over the prior art.

The Federal Circuit also went on to state:

The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. . . . Here the Examiner relied upon hindsight to arrive at the determination of obviousness. It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that one cannot use hindsight reconstruction to pick



and choose among isolated disclosures in the prior art to deprecate the claimed invention. Fritch at 1784-85, citing In re Gordon, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984).

Here, there is no suggestion that Smyth, alone, or in combination with Huang and O'Brien teaches a structure and method containing all of the limitations of the claimed invention. Consequently, there is absent the "suggestion" or "objective teaching" that would have to be made before there could be established the legally requisite "prima facie case of obviousness." In view of the foregoing, the Applicants respectfully submit that the collective cited prior art do not teach or suggest the features defined by amended independent claims 1, 11, 12, 22, 23, and 33 and as such, claims 1, 11, 12, 22, 23, and 33 are patentable over Smyth, alone, or in combination with Huang and O'Brien. Further, dependent claims 2-10, 13-21, and 24-32 are similarly patentable over Smyth, alone, or in combination with Huang and O'Brien, not only by virtue of their dependency from patentable independent claims, respectively, but also by virtue of the additional features of the invention they define. Thus, the Applicants respectfully request that these rejections be reconsidered and withdrawn.

Moreover, the Applicants note that all claims are properly supported in the specification and accompanying drawings, and no new matter is being added. In view of the foregoing, the Examiner is respectfully requested to reconsider and withdraw the rejections.

### III. Formal Matters and Conclusion

With respect to the objections/rejections to the claims, the claims have been amended, above, to overcome these objections/rejections. In view of the foregoing, the Examiner is respectfully requested to reconsider and withdraw the rejections to the claims.

In view of the foregoing, Applicants submit that claims 1-33, all the claims presently

pending in the application, are patentably distinct from the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue at the earliest possible time.

Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary. Please charge any deficiencies and credit any overpayments to Attorney's Deposit Account Number 09-0441.

Respectfully submitted,

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